

**REMARKS**

Applicants amend claims 5, 14, and 25-27. Claims 5, 7-16, and 25-28 remain pending and under examination, with claims 17-24 withdrawn from consideration.

In the Office Action,<sup>1</sup> the Examiner rejected claim 26 under 35 U.S.C. § 112, second paragraph; rejected claims 5, 7-16, 25, 27, and 28 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,259,405 to Stewart et al. ("Stewart") in view of U.S. Patent No. 6,563,919 to Aravamudhan et al. ("Aravamudhan"); and rejected claim 26 under 35 U.S.C. § 103(a) as being unpatentable over Stewart in view of Aravamudhan, and further in view of U.S. Patent No. 6,072,875 to Tsudik ("Tsudik"). Applicants respectfully traverse the Examiner's rejections.

**I. Regarding the rejection of claim 26 under 35 U.S.C. § 112**

In the Office Action, the Examiner rejected claim 26 under 35 U.S.C. § 112, second paragraph for insufficient antecedent basis. By this amendment, Applicants amend claim 26 to obviate the rejection. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claim 26 under 35 U.S.C. § 112, second paragraph.

**II. Regarding the rejection of claims 5, 7-16, 25, 27, and 28 under 35 U.S.C. § 103(a) as being unpatentable over Stewart in view of Aravamudhan**

Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 5, 7-16, 25, 27, and 28 as being unpatentable over Stewart in view of Aravamudhan because a prima facie case of obviousness has not been established with respect to these claims.

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<sup>1</sup> The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). M.P.E.P. § 2142, 8th Ed., Rev. 2 (May 2004), p. 2100-128.

A *prima facie* case of obviousness has not been established because, among other things, neither Stewart nor Aravamudhan, taken individually or in combination, teaches or suggests each and every element of Applicants' claims.

Independent claim 5 recites a service-providing system including, for example, a wireless gateway that "converts the user identifier to a temporary identifier to conceal the user identifier, . . . and sends service request information without the user identifier and without the temporary identifier to the service provider, the service request information including the service request identifier, the service provider name, the location information, and the parameter." Stewart does not teach or suggest at least these elements. Stewart always transmits an "ID code" from the personal communication device to an access point, and the access point receives the ID code and transfers the ID code to the service provider. Stewart, Fig. 5, step 510; see also Stewart, col. 14: 3-5. The service provider then returns information to the personal communication device based on the ID code and the location information. Stewart, col. 14: 19-24. Always sending an "ID code", as taught by Stewart, does not constitute a teaching or suggestion of "convert[ing] the user identifier to a temporary identifier to conceal the user identifier, . . . and send[ing] service request information without the

user identifier and without the temporary identifier to the service provider,” as recited by claim 5.

Although Stewart discloses: “If the ID code is determined to not be authorized in step 530, then a service provider may optionally offer services to a MU [mobile unit] that is not registered with the service provider,” this determination relates to whether a mobile unit is registered with the service provider. Stewart, col. 14: 40-42. In order to determine if the unit is registered, however, Stewart must send the identification of the mobile unit to the service provider. See Stewart, col. 14: 3-5. In contrast, claim 5 recites “convert[ing] the user identifier to a temporary identifier to conceal the user identifier, . . . and send[ing] service request information without the user identifier and without the temporary identifier to the service provider” (emphasis added).

Furthermore, the Examiner has not identified what portions of Stewart allegedly teach or suggest the claimed “service request identifier” and “service provider name.” Stewart does not teach or suggest a wireless gateway that stores and sends a “service request identifier” and a “service provider name” to a service provider, as recited by claim 5.

Moreover, independent claim 5 recites a service-providing system including, for example, “a location information provider configured to provide a location information of the mobile terminal to the mobile terminal” (emphasis added). The Examiner asserts that Stewart discloses this element in col. 6, lines 4-24. Office Action at 3. The cited portion of Stewart discloses, in part: “the PCD [Portable Computing Device] 110A may include GPS (Global Positioning System) equipment to enable the PCD 110A to provide its geographic location through the AP [Access Point] to the network.” Stewart, col. 6,

lines 20-23. Providing a geographic location from a portable computing device to a network, as taught by Stewart, does not constitute a teaching or suggestion of “location information provider configured to provide a location information of the mobile terminal to the mobile terminal,” as recited by claim 1 (emphasis added).

Aravamudhan fails to cure the deficiencies of Stewart. The Examiner relies on Aravamudhan for allegedly disclosing “a gateway that converts the user id to a temporary identifier and stor[es] the user id and the temporary id in a correspondence table.” Office Action at 5. Although Aravamudhan discloses a gateway that converts a network specific ID to a network transparent ID, Aravamudhan forwards the message “having the NTI [network transparent identifier] . . . to the UMM 30 [Unified Mobility Manager].” Aravamudhan, col. 9:40-52). Transmitting the network transparent ID, as taught by Aravamudhan, does not constitute a teaching or suggestion of “convert[ing] the user identifier to a temporary identifier to conceal the user identifier, . . . and send[ing] service request information without the user identifier and without the temporary identifier to the service provider,” as recited by claim 5 (emphasis added).

Because neither Stewart nor Aravamudhan, taken individually or in combination, teach or suggest each and every element recited by claim 5, no prima facie case of obviousness has been established for claim 5. Claims 7-13, 25, 27, and 28 depend from claim 5 and therefore include all of the elements recited therein. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 5, 7-13, 25, 27, and 28 under 35 U.S.C. § 103(a) as being unpatentable over Stewart in view of Aravamudhan.

Independent claim 14, although of different scope, recites elements similar to those recited by independent claim 5. Accordingly, for at least the reasons discussed above with respect to claim 5, no prima facie case of obviousness has been established for independent claim 14.

Moreover, independent claim 14 recites a service-providing system including: “a user identification service provider configured to provide a first service relevant to a user identification to the mobile terminal; [and] a user non-identification service provider configured to provide a second service that is not relevant to a user identification to the mobile terminal” (emphasis added). Stewart only discloses a single service provider 140. Stewart, Fig. 1A. A single service provider, as taught by Stewart, does not constitute a teaching or suggestion of a “user identification service provider” and a “user non-identification service provider,” as recited by claim 14.

Aravamudhan fails to cure this additional deficiency of Stewart, nor does the Examiner rely on Aravamudhan for such teachings. Therefore, for at least this additional reasons, no prima facie case of obviousness has been established for claim 14. Accordingly, Applicants respectfully request withdrawal the rejection of independent claim 14 and dependent claims 15-16 under 35 U.S.C. § 103(a) as being unpatentable over Stewart in view of Aravamudhan.

**III. Regarding the rejection of claim 26 under 35 U.S.C. § 103(a) as being unpatentable over Stewart in view of Aravamudhan, and further in view of Tsudik**

Applicants respectfully traverse the Examiner’s rejection of claim 26 under 35 U.S.C. § 103(a) as being unpatentable over Stewart in view of Aravamudhan, and

further in view of Tsudik because a prima facie case of obviousness has not been established with respect to this claim.

Claim 26 depends from independent claim 5 and therefore includes all of the elements recited therein. Tsudik fails to cure the deficiencies of Stewart and Aravamudhan discussed above, nor does the Examiner rely on Tsudik for such teachings. See Office Action at 8.

Because none of Stewart, Aravamudhan, and Tsudik, taken individually or in combination, teach or suggest each and every element recited by claim 5 and required by claim 26, no prima facie case of obviousness has been established for claim 26. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claim 26 under 35 U.S.C. § 103(a) as being unpatentable over Stewart in view of Aravamudhan, and further in view of Tsudik.

#### **IV. Conclusion**

Applicants respectfully request that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing this application in condition for allowance. Applicants submit that the proposed amendments of claims 5, 14, and 25-27 do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

Furthermore, Applicants respectfully point out that the final action by the Examiner presented some new arguments as to the application of the art against Applicant's invention. It is respectfully submitted that the entering of the Amendment

would allow the Applicants to reply to the final rejections and place the application in condition for allowance.

Finally, Applicants submit that the entry of the Amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

In view of the foregoing remarks, Applicants submit that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.


Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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By: \_\_\_\_\_

  
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